THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. YAPEL,
KENT D. NELSON, THOMAS M. MILBOURN,
and RICHARD J. FOSS

Appeal No. 96-3741
Application 08/177,288[1]

ON BRIEF

Before GARRIS, PAK, and LIEBERMAN, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 20. On page 1 of the brief, the

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[1] Application for patent filed January 4, 1994.

appellants have indicated that they are not appealing the rejections of claims 1, 2, 4, 5, 8, 10 and 11. As a result, we dismiss the appeal as to these claims thereby leaving for our consideration on this appeal claims 3, 6, 7, 9 and 12 through 20. The only other claims in the application, which are claims 21 through 24, stand withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a coater apparatus enclosure. This appealed subject matter is adequately illustrated by dismissed independent claim 1 and appealed claims 3 and 6 which depend therefrom. A copy of these claims is set forth below:

1. A coater apparatus enclosure for enclosing the entire coating applicator portion of a coating apparatus comprising:

an enclosure; and

means for continuously supplying solvent-saturated gas to the enclosure to prevent premature drying of coating fluid.

3. The coater apparatus enclosure of claim 1 further comprising means for controlling gas flow to the enclosure.

6. The coater apparatus enclosure of claim 1 wherein the solvent-saturated gas includes a solvent which is a cosolvent mixture in equilibrium with the coating fluid.

The following references are relied upon by the examiner in the rejections before us:

Fronheiser	4,835,021	May 30, 1989
German patent (German '402)	4 316 402	Nov. 24, 1994

(Research Disclosure), "Manufacturing of solvent-based image-forming materials," Research Disclosure, pp. 111-117 (1992).

All of the appealed claims are rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Claim 6 stands finally rejected under 35 U.S.C. § 102(b) as being anticipated by German '402.[2]

Claims 3, 12 and 14 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over German '402.[3]

Claim 15 stands finally rejected under 35 U.S.C. § 103 as being unpatentable over German '402 in view of Fronheiser.

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[2] By an apparently inadvertent error, the examiner in her answer has included claim 14 in this rejection. We will consider this rejection to not include claim 14 in order to be consistent with the final rejection.

[3] Again by an apparently inadvertent error, the examiner in her answer has excluded claim 12 and included claim 15 in this rejection. We will consider the rejection to include claims 3, 12 and 14 as noted above in order to be consistent with the final rejection.

Lastly, claims 7 and 9 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over German ‘402 in view of Research Disclosure.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

For the reasons which follow, we will sustain only the section 102 rejection of claim 6 and the section 103 rejections of claims 3, 12, 14 and 15.

Concerning the section 112, second paragraph, rejection, the examiner argues “[c]laims 3, 6-7, 9 and 12-20 are vague and indefinite since applicant recites the relationship of the elements of the coating applicator or coating apparatus yet applicant has failed to claim the enclosure in combination with the coating applicator and backup support” (answer, pages 7-8). From our perspective, the appealed claims circumscribe a particular area with a reasonable degree of precision and particularity vis à vis whether the area of a given claim is directed to an enclosure or an enclosure in combination with

other apparatus elements. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The examiner has proffered no cogent rationale in support of a contrary view. It follows that we will not sustain her section 112, second paragraph, rejection of the claims before us.

As for the section 102 rejection of claim 6, we agree with the examiner that the cosolvent mixture recitation of this claim fails to distinguish over the apparatus disclosed in the German reference. According to the appellants, this claim 6 recitation "is a restriction on the claimed coater apparatus and structurally limits the apparatus claim" (brief, page 8). This is incorrect as a matter of law. See, for example, In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) (manner or method in which a machine is to be utilized is not germane to patentability of the machine itself). We shall, therefore, sustain the rejection of claim 6 under 35 U.S.C. § 102(b) as being anticipated by German '402.

We will also sustain the section 103 rejection of claims 3, 12 and 14 as being unpatentable over German '402. The appellants argue that "[c]laims 3 and 14 both require 'means

for controlling the gas flow to the enclosure'" and that "[t]his is not disclosed in nor obvious from the German reference" (brief, page 7). This argument is factually erroneous and therefore unpersuasive in two respects. In the first place, only claim 3 requires such a control means; claim 14 plainly does not. Secondly, and in any event, the German reference unquestionably discloses such a control means (e.g., see element 8 of the drawing and the third full paragraph on page 3 of the German translation of record). With the respect to claim 12, we simply disagree with the appellants' argument that it would not have been obvious to provide the apparatus of the German reference with an access door as required by this claim. In our opinion, one with ordinary skill in the art would have been motivated and found it obvious to provide box 23 of the German apparatus with a door in order to obtain access to the apparatus components within the box for purposes of service such as cleaning, repair or replacement.

Moreover, we are unconvinced by appellants' argument concerning the vacuum chamber feature of claim 15. Significantly, this argument addresses only the German reference rather than the combination of the German and

Fronheiser references upon which the rejection is based. It is well settled that applicants can not show nonobviousness by attacking references individually where, as here, the rejection is based on a combination of references. In re Young, 403 F.2d 754, 757, 159 USPQ 725, 728 (CCPA 1968). Additionally, the appellants remark that "from the Figure in the German reference, it is not obvious that a vacuum box could be physically inserted into it at all" (brief, page 11). Nevertheless, it is also well settled that, to justify combining reference teachings in support of a rejection, it is not necessary that a device (such as the vacuum box of Fronheiser) shown in one reference can be physically inserted into the device shown in the other reference (i.e., German '402). In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Accordingly, the section 103 rejection of claim 15 as being unpatentable over German '402 in view of Fronheiser likewise will be sustained.

However, we can not sustain the examiner's section 103 rejection of claims 7 and 9 as being unpatentable over German '402 in view of Research Disclosure. As correctly indicated by the appellants, the applied references simply do not show

and thus would not have suggested the packed column/wick feature of claim 7 or the first and second heat exchangers feature of claim 9. In essence, the examiner's obviousness conclusions with the respect to these claims lack the evidentiary support required to establish a prima facie case of obviousness.

As a final matter of concern, we observe that the first and final Office actions of record in this application have been disassembled and then misplaced or reassembled in an inappropriate manner. Upon return of this application to the jurisdiction of the Examining Corps, these Office actions should be reconstructed so as to restore the filed record to its proper official condition.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Bradley R. Garris Administrative Patent Judge	)	
Chung K. Pak Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Paul Lieberman Administrative Patent Judge	)	

tdc

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